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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/716,555      | 11/20/2003  | David Joseph Preskar | 241574US26          | 5686             |

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| EXAMINER |
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STASHICK, ANTHONY D

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| ART UNIT | PAPER NUMBER |
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3728

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,555

Applicant(s)

PRESKAR ET AL.

Examiner

Anthony Stashick

Art Unit

3728

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-33 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-39 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,15,16,21-24,26,29-33 and 35 is/are rejected.
- 7) ☒ Claim(s) 6-14,17-20,27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-20, 29-33 and 34 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the phrase "said cushioning spring" in line 10 of the claim, which renders the claims so. There is insufficient antecedent basis for this limitation in the claim. Claim 29 contains the phrase "said plurality of cushioning elements in lines 6 and 7 of the claim that renders the claim vague and indefinite. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Allen 5,203,095.

Allen '095 discloses all the limitations of the claim including the following: a sole assembly 10; a cushioning arrangement 114, 116, 130 disposed within the sole assembly; at least one cushioning element 130; a stiffening spring 114, 116 at least partially surrounding the at least one cushioning element; the stiffening spring has a stiffness greater than the at least one cushioning

Art Unit: 3728

element (see col. 4, line 63-col. 5, line 25); a portion of the cushioning spring is disposed adjacent to a periphery of the shoe (see Figure 4) and the stiffening spring at least partially defines an aperture (see Figure 4, spring 114 and 116 defines aperture); said at least one cushioning element is disposed in the aperture such that the at least one cushioning element can be seen and touched from an exterior of the shoe (see Figure 4).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-5, 21, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen 5,203,095, as applied to claim 1 above, in view of Lombardino 6,751,891. Allen '095 as applied to claim 1 above discloses all the limitations of the claims except for a plurality of cushioning elements disposed in the aperture, the positioning of the elements. Lombardino '891 teaches that a cushion located within a sole can include multiple cushioning elements 24 with a stiffer spring 50 located around the cushioning element to give a stiffer cushioning to the element. Lombardino '891 also teaches that the cushioning element can be made of 6 elements, with spaces between the elements, located laterally of each other and extending, staggered, from the lateral side of the element to the medial side of the element (see Figure 6). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushioning element out of multiple cushioning elements spaced apart and across the

Art Unit: 3728

sole of the shoe, as taught by Lombardino '891, to allow for flexibility in the cushioning of the impact of the user's foot with the ground.

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen 5,203,095 as applied to claim 1 above, in view of Preman et al. 5,224,280. Allen '095 as applied to claim 1 above, discloses all the limitations of the claims, including the bottom of the spring being substantially flat (see Figure 4) and the springs having similar stiffnesses, but does not disclose the top of the stiffening spring being curved. Allen '095 does not disclose the stiffening spring having a curved top disposed above at least one cushioning element. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curve to help in absorbing the impact of a user's foot with the ground. Therefore, it would have been obvious to make the top wall of the stiffening spring of Allen '095 curved to aid in cushioning the impact of the user's foot with the ground.

8. Claims 23, 24, 29-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 21 above in view of Preman et al. 5,224,280. The references as applied to claim 21 above disclose all the limitations of the claims, including the cushioning elements being hour-glass shaped (see Lombardino '891, Figure 10), the cushioning elements being truncated cones (again, see Figure 10), but does not teach the top of the stiffening spring being curved. Preman et al. '280 teaches that the top wall 13 of a stiffening spring 4 can be curve to help in absorbing the impact of a user's foot with the ground. Therefore, it would

Art Unit: 3728

have been obvious to make the top wall of the stiffening spring of the references as applied to claim 21 above, curved to aid in cushioning the impact of the user's foot with the ground.

***Allowable Subject Matter***

9. Claims 36-39 are allowed over the prior art of record.
10. Claims 6-14 and 17-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
11. Claims 25 and 27-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

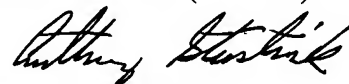
Art Unit: 3728

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS